

REMARKS / ARGUMENTS

In view of the following remarks and arguments, Applicant believes the pending application is in condition for allowance. Reconsideration is respectfully requested.

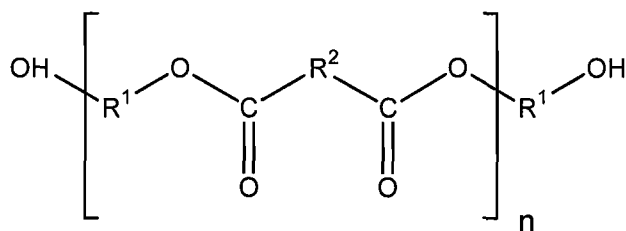
I. Status of the Claims

Claims 1-10 are pending and are presented herein as a courtesy to the Examiner. No amendment to the claims is made.

II. Claim Rejections under 35 U.S.C. § 102(b)

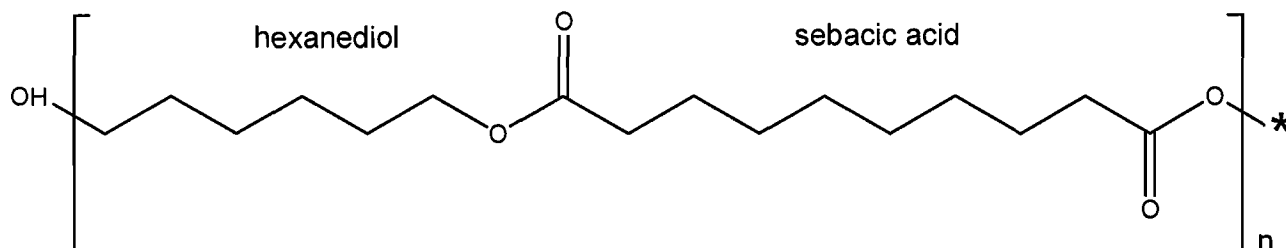
Claims 1-3 and 6-10 are rejected under 35 U.S.C. § 102(b) as anticipated by United States Patent No. 6,221,978 to Li et al. ("Li") when taken with DYNACOLL® polyester data from Degussa® ("Degussa"). The Examiner contends that Li taken with Degussa discloses every element recited in the claims. Applicant respectfully traverses the rejections.

Claim 1 recites the element of "long-chain aliphatic polyester polyol (A) represented by a general formula (I)" ("the aliphatic polyester polyol element"). The general formula (I) has the following formula.



Here, R^1 and R^2 each independently represent a straight chain alkylene group having an even number of carbon atoms, the sum of the numbers of carbon atoms in R^1 and R^2 is 12 or more, and n represents a number of 3 to 40.

The Examiner asserts that Li discloses the aliphatic polyester polyol element of claim 1 because it teaches an aliphatic polyester polyol of the following formula.¹



Applicant respectfully submits that Li does not disclose such an aliphatic polyester polyol.

The Examiner points to column 3, lines 15 and 28 of Li as disclosing an aliphatic polyester polyol of the formula above.² There, Li describes polyester polyols that may be prepared by reacting a diacid with a diol. It further discloses “sebacic acid” as an example of an aliphatic diacid³ and “1,6-hexanediol” as an example of a diol.⁴

However, the polyester polyols taught by Li are those prepared by reacting “diacid comprising an aromatic diacid and optionally co-monomer diacid(s) with diol.”⁵ In other words, Li’s polyester polyol necessarily contains an aromatic diacid component. As an example of aromatic diacid, Li discloses “terephthalic acid, isophthalic acid, derivatives thereof, and mixtures thereof.”⁶

¹ Office Action mailed October 17, 2007, page 2, line 12 ~ page 3, line 4.

² *Id.*, page 3, line 1.

³ Li, column 3, line 15.

⁴ *Id.*, column 3, lines 28-29.

⁵ *Id.*, column 3, lines 4-6.

⁶ *Id.*, column 3, lines 8-10.

Since the polyester polyol the Examiner presents does not contain an aromatic diacid component, it is not disclosed by Li.

Further, Li discloses aliphatic diacids such as the “sebacic acid” presented above only as an example of the optional “diacid co-monomer(s).”⁷ Since these aliphatic diacids are specifically described to be “co-monomer(s),” they are by definition incorporated into the polyester polyol chains together with aromatic acid: they cannot independently form a polyester polyol chain with a given diol without an aromatic acid. For this additional reason, Li does not disclose the polyester polyol presented by the Examiner.

Accordingly, Li does not disclose the aliphatic polyester polyol element recited in claim 1. Degussa also does not disclose this element. At least for these reasons, Li taken with Degussa does not disclose every element recited in claim 1 and thus does not anticipate claim 1. Applicant respectfully requests that the rejection of claim 1 be withdrawn.

Claims 2, 3, and 6-10 depend directly or indirectly from claim 1. Therefore, at least for the same reasons as stated above, Li taken with Degussa does not anticipate these claims. Applicant respectfully requests that the rejections of claims 2, 3, and 6-10 be withdrawn.

III. Claim Rejections under 35 U.S.C. § 103(a)

Claims 4 and 5 are rejected under 35 U.S.C. § 103(a) as unpatentable over Li when taken with Degussa and further in view of United States Patent No. 4,312,973 to Critchfield et al. (“Critchfield”). The Examiner contends that Li taken with Degussa and in combination with Critchfield renders the claims obvious. Applicant respectfully traverses the rejections.

⁷ *Id.*, column 3, lines 11-18.

Since claims 4 and 5 depend from claim 1, they both contain the aliphatic polyester polyol element of claim 1.

The Examiner's rejections of claims 4 and 5 on the ground of *prima facie* obviousness is predicated on the assertion that Li taken with Degussa teaches the aliphatic polyester polyol element recited in claim 1.⁸ However, as discussed above, Li together with Degussa does not disclose the aliphatic polyester polyol presented by the Examiner. Further, Applicant respectfully submits that Critchfield also does not disclose the aliphatic polyester polyol element of claim 1.

At least for these reasons, Li taken with Degussa and further in view of Critchfield does not render claims 4 and 5 obvious. Applicant respectfully requests that the rejections thereof be withdrawn.

⁸ Office Action mailed October 17, 2007, page 5, line 1 ("Li teaches the composition as set forth in claims 1-3 and 6-10 above").

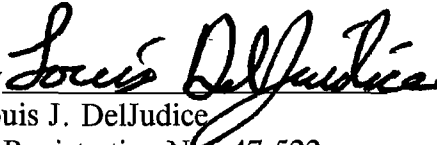
CONCLUSION

In view of the foregoing, it is believed that claims 1-10 are in immediate condition for allowance and it is respectfully requested that the application be reconsidered and that all pending claims be allowed and the case passed to issue.

If there are any other issues remaining which the Examiner believes could be resolved through a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

Dated: February 15, 2008

Respectfully submitted,

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